



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,732	12/28/2001	Yasushi Ohwa	036741-0109	4070
22428	7590	01/25/2006		
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER RUDOLPH, VINCENT M	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/028,732

Applicant(s)

OHWA, YASUSHI

Examiner

Vincent M. Rudolph

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-7 and 9-14 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claims 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 15 and 16, the prior art does not disclose monitoring the consumption amount of the recording medium for only one type of paper/output and not any other types.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito ('384) in view of Garr ('420).

Regarding claim 4, Ito ('384) discloses an information distribution system, or a questionnaire agency system, that includes a distribution server, or a retrieval unit (See Figure 1, Element 4), to distribute the stored questionnaire and the reply number to the selected people chosen (See Col. 5, Line 65-Col. 6, Line 3). A distribution terminal (See Figure 3, Line Element 15-1 to 15-3) contains the terminals of the answerers that receive the information from the distribution server (See Figure 3; Col. 4, Line 14-15). The distribution information, or questionnaire according to Ito ('384), is received so the

Art Unit: 2624

answerer can reply to the questionnaire sent and transmit it back to the number specified on the sheet (See Col. 6, Line 7-10). The distribution information includes an object information element, or a questionnaire content according to Ito ('384), which the answerer replies to and also has the control information element, or the requested company number according to Ito ('384), so the answerer can be directed where to send the reply that corresponds to the questionnaire (See Col 5, Line 65-Col. 6, Line 1). The distribution terminal can be one of several terminals, such as a facsimile or computer terminal (See Col. 4, Line 16-17) to which the answerer can reply. The terminal has a user interface for returning the questionnaire to the requesting company, such as a fax number specified by the company (See Col. 7, Line 60-64). Ito ('384) does not explicitly state that the distribution terminal contains a data output for printing data on a predetermined recording medium, such as paper. It is inherent for one of ordinary skill that Ito ('384) provides data printed on a recording medium (See Col. 7, Line 60-61) where Ito ('384) discusses the questionnaire that is received, and the receiver responds to the fax number specified by the agency. Thus, the examiner concludes that a printed document is received from the distribution terminal because the receiver is responding to the questionnaire.

Ito ('384) does not disclose the distribution terminal having the ability to monitor the consumption amount of the recorded medium and inform the distribution server that amount.

Garr ('420) discloses the distribution terminal can detect the consumption amount, or toner level, of the cartridge and the number of pages that can still be printed

Art Unit: 2624

using that cartridge (See Col. 10, Line 40-43). This information is then passed onto the distribution server, or host computer (See Col. 10, Line 47-49).

It would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have added the consumption amount disclosed by Garr ('420) and incorporate it into the distribution terminal of Ito ('384) because the terminal can report to the distribution server an updated ink toner level so the distribution server knows how many questionnaires can be sent before the consumption amount is empty.

Regarding claim 2, according to MPEP § 2112.01(III), "Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art." Therefore, the advertisement information containing a questionnaire disclosed by the applicant will not be given any weight. That being said, Ito ('384) discloses the object information element deals with a survey (See Col. 4, Line 6-8) by which answerers registered through an advertisement (See Col. 9, Line 10-16). The response information included with the questionnaire is the fax number by which the answerer replies to through the user interface of the facsimile (See Col. 7, Line 60-66).

Regarding claim 3, Ito ('384) discloses a distribution terminal is a facsimile machine (See Figure 3, Element 15-1 to 15-3; Col. 4, Line 14-16) which has a transmission information judging unit, such as a bar code scanner, to determine if a number is entered or not (See Col. 8, Line 5-12). The object information element, or the received content according to Ito ('384), includes the questionnaire part and the

Art Unit: 2624

distribution information of the agency within the paper so the facsimile can scan the bar code, know it is the distribution information and transmit it to the designated area (See Col. 8, Line 5-12). Also, prior to the answerer transmitting the recorded completed questionnaire through the facsimile, the user receives and completes the questionnaire content which contains a question area and a distribution information displaying area, such as the reply fax number or a bar code, to send the content back (See Col. 7, Line 60-Col. 8, Line 15). A transmission judging unit decides if the distribution information includes a bar code or not for returning to the distribution server (See Col. 8, Line 5-12). If not, a fax number is included so the facsimile can execute the processing in accordance with the control information element (See Col. 7, Line 60-66).

Regarding claim 5, Ito ('384) discloses a distribution server, or a retrieval unit, located within the agency questionnaire system (See Figure 3).

Ito ('384) does not disclose the distribution server having a recording medium consumption recovering process, which recovers the consumption amount disclosed by the distribution terminal.

Garr ('420) discloses a distribution server, or host computer, capable of receiving the consumption amount, or toner level, from the distribution terminal once it determines to send the information to the distribution server (See Col. 10, Line 46-49). The distribution server can then make a recovery means such as calculating the number of pages remaining in the terminal (See Col. 14, Line 27-33).

It would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have added the consumption amount calculation disclosed

Art Unit: 2624

by Garr ('420) and incorporate it into the distribution server of Ito ('384) because the distribution terminal can send the consumption amount to the distribution server, which can then calculate the pages remaining. By calculating and storing this information in the answerer's information, the distribution server will know how many questionnaires to send before the consumption amount needs replaced.

Regarding claim 6, Ito ('384) discloses the information distribution system has a distribution server with a database in it, or just a database unit (See Figure 1, Element 2) according to Ito ('384), which manages and accumulates answerer information (See Figure 4; Col. 4, Line 31-49). This is done through an investigation process through the network where the answerer's personal information is updated when the retrieval unit (See Figure 2, Element 11) executes the distribution information and updates the attribute information accordingly (See Col. 6, Line 10-17) so an agency can determine who best fits their criteria for sending the questionnaire (See Col. 4, Line 66-Col. 5, Line 5).

Regarding claim 7, Ito ('384) discloses the distribution server, or the retrieval unit according to Ito ('384), has response information coping means so when it receives the response information from the answerer's distribution terminal, the retrieval unit processes the information, accumulates and updates the answerer's information (See Col. 6, Line 8-17).

Regarding claims 11, 9-10 and 12-14, the rationale provided in rejection of claims 4, 2-3 and 5-7 is incorporated herein respectively. In addition, the system of claims 4,

2-3 and 5-7 corresponds to the service of claims 11, 9-10 and 12-14 and performs the steps disclosed, respectively.

### ***Response to Arguments***

Applicant argues that Ito ('384) in view of Garr ('420) does not disclose monitoring a consumption amount consumed at the time of printing/outputting an advertisement with a questionnaire and instead Garr ('420) discloses a predication of the exchanging timing of toner cartridge. Even though Ito ('384) in view of Garr ('420) does not fully disclose monitoring a consumption amount relating to an advertisement with a questionnaire, it does meet the claimed limitation of independent claims 4 and 11. For example, Garr ('420) does disclose a consumption amount, which is the toner level of the cartridge, which is then passed onto the distribution server after the completion of a print job (See Col. 10, Line 40-49). Thus, by incorporating that into the information distribution system of Ito ('384), the distribution server is able to monitor how many questionnaires to send in relation to the consumption amount remaining. Based on these facts, this action is made final.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Ariga (Pub. # 2002/0055877), Mazzagatte (Pub. # US 2002/0083114) and Shimada ('966).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent M. Rudolph whose telephone number is (571)



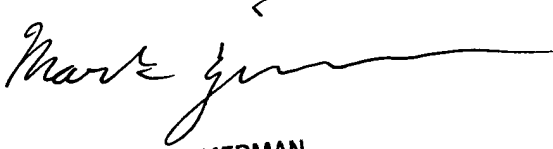
Art Unit: 2624

272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vincent M. Rudolph  
Examiner  
Art Unit 2624

  
MARK ZIMMERMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600